

**REMARKS**

**I. Status of the Claims**

Before this amendment, claims 1-122 were pending. Without prejudice or disclaimer, claims 1, 27, 60, 89, and 115-117 are amended to recite the limitations of claims 6, 18, 32, 44, 65, and 94. Without prejudice or disclaimer, claims 18, 44, 77, and 106 are amended herein. Without prejudice or disclaimer, claims 2-6, 28-32, 61-65, 90-94, and 118 are cancelled herein. Without prejudice or disclaimer, claims 119-122 are amended herein to correct their dependencies. Exemplary support for the amendments can be found in the specification and claims as-filed. Therefore, claims 1, 7-27, 33-60, 66-89, 95-117, and 119-122 are presently pending.

Applicants respectfully acknowledge that the rejection of claims 1-6, 10-13, 24-32, 36-39, 50-65, 69-72, 83-84, 86-94, 98-101, and 112-118 under 35 U.S.C. § 102(b) as allegedly anticipated by U.S. Patent No. 5,961,998 to Arnaud et al. ("Arnaud") has been withdrawn. See Oct. 9, 2008, Final Office Action at 3. Applicants further respectfully acknowledge that the rejection of claims 1-7, 10-33, 36-52, 54-66, 69-84, 86-95, and 98-118 under 35 U.S.C. § 102(e) as allegedly anticipated by U.S. Patent Application Publication No. 2003/0017124 A1 to Agostini et al. ("Agostini") has been withdrawn. See *id.*

**II. Interview Summary**

Applicants' undersigned representative would like to thank Examiner Rogers for his time during the telephonic interview on January 13, 2009, to discuss the outstanding Final Office Action and for providing an Interview Summary form PTOL-413 dated

January 16, 2009. Applicants agree with the Interview Summary in that no agreement was reached.

### **III. Rejection Under 35 U.S.C. § 112**

The Examiner rejects claims 1, 7, 20, 27, 33, 46, 60, 66, 79, 89, 95, 108, and 115-117 under 35 U.S.C. § 112, first paragraph for allegedly failing to comply with the written description requirement. See Oct. 9, 2008, Final Office Action at 2-3.

Specifically, the Examiner asserts that the ranges of (1) 5 to 60% of the high viscosity phenyl siloxane oil; (2) 5 to 60% of the non-volatile ester oil; and (3) 5 to 80% of the low viscosity phenylsiloxane oil are not supported by the specification. See *id.* The Examiner notes that paragraphs [0047] and [0067] of the specification as-published (U.S. Patent Application Publication No. 2004/0126350 A1) allegedly only provide support for 10 to 60% of both the high viscosity phenyl siloxane oil and the non-volatile ester oil, and paragraph [0048] allegedly only provides support for 7.5 to 80% of the low viscosity phenylsiloxane oil. See *id.*

Applicants respectfully disagree and traverse for the following reasons. The question is “whether the specification conveys with reasonable clarity to those skilled in the art that, as of the filing date sought, applicant was in possession of the invention as now claimed.” M.P.E.P. § 2163.02. The subject matter need not be described literally, i.e., using the same terms. *Id.* This is even true with respect to claim ranges. *Union Oil Co. of California v. Atlantic Richfield Co.*, 54 U.S.P.Q.2d 1227, 1233 (Fed. Cir. 2000) (“[R]anges found in applicant’s claims need not correspond exactly to those disclosed in [the specification] . . .”).

Applicants submit that the decision in *In re Wertheim*, 191 U.S.P.Q. 90 (C.C.P.A. 1976), is particularly relevant. The *Wertheim* Court considered whether the limitation “at least 0.25 mm” was supported by the application’s specification. *Id.* at 99. The Office had rejected the claim because the only range recited in the specification was “0.25 to 2.0 mm.” *Id.* The Court concluded that there was Section 112 support for the claim because the specification suggested that a wide range was possible and clearly stated that the 0.25 to 2.0 mm was merely preferred. *Id.*

Here, the present specification teaches that:

The high-viscosity phenylsilicone oil may be present in the composition in an amount ranging from 5 to 99% of the total weight of the composition, for example from 7.5 to 80%, and further, for example, from 10 to 60%, and still further, for example, from 20 to 50%.

The low-viscosity phenylsilicone oil (if present) may be present in the composition in an amount ranging from 5 to 99% of the total weight of the composition, for instance from 7.5 to 80%, for example from 10 to 60% and for example from 10 to 40%.

. . . .

The non-volatile hydrocarbon oil may be present in the composition in an amount ranging from 5 to 99%, for example from 10 to 60%, and for example from 15 to 50%, relative to the total weight of the composition.

Specification as-published at ¶¶ [0047], [0048], and [0067]. Thus, like the application in *In re Wertheim*, the specification shows the range 10 to 60% of both the high viscosity phenyl siloxane oil and the non-volatile ester oil, and 7.5 to 80% of the low viscosity phenylsiloxane oil to merely be a preference, and that Applicants expressly contemplated that the ranges of the high-viscosity phenylsilicone oil, low-viscosity phenylsilicone oil, and non-volatile hydrocarbon oil may vary within the wide range

disclosed. See M.P.E.P. § 2163.02 (“[S]ubject matter of the claim need not be described literally (*i.e.*, using the same terms or *in haec verba*) in order for the disclosure to satisfy the description requirement.”). Applicants’ specification provides a further range of “5 to 99%” for each of the three aforementioned components, which expressly encompasses the range “5 to 60%” and “5 to 80%.”

For these reasons, Applicants respectfully submit that the specification as-filed provides written description support for the claimed ranges for each of the aforementioned components and the rejection should be withdrawn.

#### **IV. Rejection Under 35 U.S.C. § 103(a)**

##### **A. Agostini**

The Examiner rejects claims 1-122 under 35 U.S.C. § 103(a) as being unpatentable over Agostini. See Oct. 9, 2008, Final Office Action at 3-6.

Applicants respectfully traverse. As Applicants noted in their response dated March 24, 2008, Agostini is disqualified as prior art under 35 U.S.C. § 103(c). The reasons why Agostini is disqualified as prior art under 35 U.S.C. § 103(c) are reiterated as follows with additional information further explaining Applicants’ rationale.

Applicants’ application was filed September 8, 2003, and claims priority of French Patent Application No. 02 11095 (“FR ’095”), filed September 6, 2002, and U.S. Provisional Application No. 60/410,955, filed September 17, 2002. Applicants submit herewith a certified English translation of FR ’095. A review of this English translation indicates that it meets all of the requirements of 35 U.S.C. § 112, and thus

provides full support for the presently filed application. Accordingly, the instant application has an effective U.S. filing date of September 6, 2002.

Agostini, which published January 23, 2003, has an effective filing date of April 10, 2002. *See* M.P.E.P. 2136.03(I) (“[T]he foreign priority date of the reference under 35 U.S.C. 119(a)-(d) (f), and 365(a) cannot be used to antedate the application filing date.”). Therefore, Agostini appears only to be available as § 102(e) prior art.

While Agostini qualifies as § 102(e) prior art, it is not available as prior art for an obviousness rejection against the current application, pursuant to 35 U.S.C. § 103(c). 35 U.S.C. § 103(c) states that subject matter that qualifies as prior art only under 35 U.S.C. §§ 102(e), (f), and/or (g) is disqualified as prior art against the claimed invention if that “subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.” Common ownership may be established by a conspicuous statement indicating that the claimed invention and a § 102(e) reference were, at the time the invention was made, commonly owned or subject to an obligation of assignment to the same person. *See* M.P.E.P. § 706.02(I)(2)(II).

#### **STATEMENT REGARDING OBLIGATION OF ASSIGNMENT**

Agostini is disqualified as prior art under 35 U.S.C. § 103(c), because the present invention and Agostini were, at the time the invention was made, subject to an obligation of assignment to the same person, *i.e.*, L'Oréal S.A., as evidenced by the assignment information recorded for Agostini on July 8, 2002, at Reel 013066, Frame 0926, and the assignment information recorded for the instant application on February 2, 2004, at Reel 014942, Frame 0378. *See* M.P.E.P. § 706.02(I)(2)(II). Accordingly,

Applicants respectfully submit that the Examiner cannot rely upon it to support the pending § 103 rejection.

Therefore, because Agostini does not qualify as legally valid prior art against the present application under 35 U.S.C. § 103(a), Applicants respectfully submit that the rejection is improper and should be withdrawn.

Furthermore, Applicants note that there are foreign counterparts of Agostini that published before the filed September 8, 2003, filing date of the present application. To the undersigned's knowledge, none of these foreign counterparts, however, published before the September 6, 2002, filing date of priority application FR '095.<sup>1</sup> While FR '095 was originally filed in French, a certified English translation is filed herewith. A review of this English translation indicates that it meets all of the requirements of 35 U.S.C. § 112, and thus provides full support for the presently filed application. Since the claim of priority has been perfected and the priority date (September 6, 2002) of the present application predates the publication dates of these foreign counterparts, the foreign counterparts of Agostini that published before the September 8, 2003, filing date of the present application are not available as § 102 prior art against the presently claimed invention.

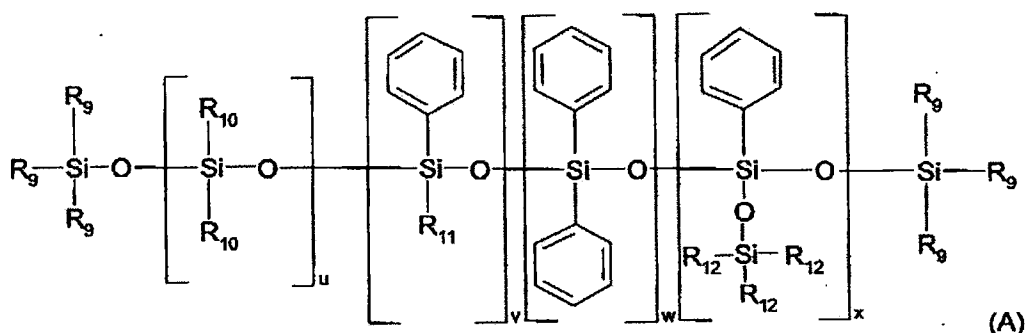
**B. Arnaud**

The Examiner maintains the rejection of claims 1-122 under 35 U.S.C. § 103(a) as allegedly unpatentable over Arnaud for the reasons of record. See Oct. 9, 2008, Final Office Action at 6.

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<sup>1</sup> To the undersigned's knowledge, none of these foreign counterparts published before the September 17, 2002, filing date of U.S. Provisional Application No. 60/410,955 as well.

While Applicants respectfully traverse for the reasons of record, solely in order to advance prosecution, Applicants have amended independent claims 1, 27, 115, and 117 to recite the limitations of claims 6, 18, 32, and 44. Specifically, amended claims 1, 27, 115, and 117 recite, among other things, that the at least one non-volatile ester is chosen from pentaerythrityl tetrapelargonate, diisostearyl malate, tridecyl trimellitate, triisocetyl citrate, pentaerythrityl tetraisnonanoate, glyceryl triisostearate, glyceryl 2-tridecyl tetradecanoate, and pentaerythrityl tetraisostearate, and the at least one high viscosity phenylsilicone oil is chosen from the oils of formula (A):



wherein:

- R<sub>9</sub> and R<sub>12</sub>, which may be identical or different, are chosen from C<sub>1</sub>-C<sub>30</sub> alkyl radicals, aryl radicals, and aralkyl radicals,
  - R<sub>10</sub> and R<sub>11</sub>, which may be identical or different, are chosen from C<sub>1</sub>-C<sub>30</sub> alkyl radicals and aralkyl radicals,
  - u, v, w and x, which may be identical or different, are integers ranging from 0 to 900,
- with the provisos that the sum of v+w+x is other than 0, and that the sum of u+v+w+x ranges from 1 to 900.

A *prima facie* case of obviousness cannot be established for the claimed invention as-amended. Specifically, one skilled in the art would not be able to arrive at the claimed invention as-amended without picking and choosing from the various disclosures of Arnaud, and one skilled in the art would not have been motivated from reading Arnaud to arrive at the claimed invention by selecting (1) at least one high viscosity phenylsilicone oil having a viscosity greater than or equal to 500 cSt present in an amount ranging from 5 to 60%, wherein the at least one high viscosity phenylsilicone oil is chosen from the oils of formula (A), and (2) at least one non-volatile ester oil chosen from pentaerythrityl tetrapelargonate, diisostearyl malate, tridecyl trimellitate, triisocetyl citrate, pentaerythrityl tetraisnonanoate, glyceryl triisostearate, glyceryl 2-tridecyl tetradecanoate, and pentaerythrityl tetraisostearate. Arnaud simply provides no guidance for choosing these particular ingredients in combination to the exclusion of the other possible components. Indeed, the Examiner acknowledges that “one of ordinary skill in the art could have selected applicants ingredients” from Arnaud. See Apr. 29, 2008, Office Action at 11 (emphasis added). Without a more definite predilection for the claimed components in the claimed amounts, Applicants respectfully submit that the Examiner cannot establish a *prima facie* case of obviousness.

Instead of providing the requisite motivation to select the claimed ingredients from the myriad ingredients listed in Arnaud, the Examiner has merely applied an impermissible hindsight analysis in order to argue that the claimed combination would have been “obvious to try.” Under *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 82 U.S.P.Q.2d 1385 (2007), and the revised M.P.E.P., an “obvious to try” rationale for *prima facie* obviousness can only be supported when there is a “finite number of



identified, predictable potential solutions to the recognized need or problem.”

M.P.E.P. § 2143(E). The possible ingredients listed in Arnaud cannot be considered “finite” the way the term was used in *KSR*, and the Examiner has offered no rational reason why, out of all the possible ingredients listed in Arnaud, one of ordinary skill would have been drawn to the ingredients recited in the claimed invention. Nothing, other than Applicants’ disclosure, teaches or suggests a cosmetic composition comprising, among other things, the claimed at least one high viscosity phenylsilicone oil having a viscosity greater than or equal to 500 cSt present in an amount ranging from 5 to 60%, wherein the at least one high viscosity phenylsilicone oil is chosen from the oils of formula (A), and at least one non-volatile ester oil chosen from pentaerythrityl tetrapelargonate, diisostearyl malate, tridecyl trimellitate, triisocetyl citrate, pentaerythrityl tetraisononanoate, glyceryl triisostearate, glyceryl 2-tridecyl tetradecanoate, and pentaerythrityl tetraisostearate.

Moreover, Applicants have also demonstrated that the claimed combination of at least one high viscosity phenylsilicone oil having a viscosity greater than or equal to 500 cSt present in an amount ranging from 5 to 60%, wherein the at least one high viscosity phenylsilicone oil is chosen from the oils of formula (A), and at least one non-volatile ester oil chosen from pentaerythrityl tetrapelargonate, diisostearyl malate, tridecyl trimellitate, triisocetyl citrate, pentaerythrityl tetraisononanoate, glyceryl triisostearate, glyceryl 2-tridecyl tetradecanoate, and pentaerythrityl tetraisostearate results in certain benefits as compared with comparative compositions containing only a high viscosity phenylsilicone oil and no claimed non-volatile ester oil, which would not have predicted. Specifically, Applicants compared compositions according to the present invention

(Example 4), which comprised phenyltrimethyltrisiloxane (a high viscosity phenylsilicone oil as-claimed) and diisostearyl malate (a non-volatile ester oil as-claimed), with three comparative compositions, which contained phenyltrimethyltrisiloxane (Examples 1-3) but no ester as-claimed. *See* Specification as-published at ¶¶ [0126]-[0130] and Table (1). Lipsticks containing the compositions were then prepared and subjected to various tests. *See id.* at ¶¶ [0131]-[0136]. The experiments demonstrated that “[t]he sticks of Examples 2 and 3 were judged to have poor deposition properties owing to an excessively soft consistency; the stick of Example 1 was adjudged to deposit well on the lips but to exhibit a loss of gloss over time.” *Id.* at ¶ [0136]. In contrast, inventive Example 4 “was adjudged to deposit well and the film of composition was adjudged to be homogeneous and glossy.” *See id.*

The results of the tests described in the specification, therefore, demonstrate the improvements associated with using the combination of, among other things, at least one high viscosity phenylsilicone oil having a viscosity greater than or equal to 500 cSt present in an amount ranging from 5 to 60%, wherein the at least one high viscosity phenylsilicone oil is chosen from the oils of formula (A), and at least one non-volatile ester oil chosen from pentaerythrityl tetrapelargonate, diisostearyl malate, tridecyl trimellitate, triisocetyl citrate, pentaerythrityl tetraisononanoate, glyceryl triisostearate, glyceryl 2-tridecyl tetradecanoate, and pentaerythrityl tetraisostearate. These benefits are not recognized by Arnaud and would not have been predictable. *See* M.P.E.P. § 2143 (identifying seven rationales for establishing obviousness, five of which require predictable results); *see also* M.P.E.P. § 2143.01(III) (“The mere fact that references can be combined or modified does not render the resultant combination obvious unless

the results would have been predictable to one of ordinary skill in the art.”) (citation omitted, second emphasis added).

Accordingly, for these additional reasons, Applicants respectfully submit that the rejection should be withdrawn.

**C. Arnaud in view of Willemin**

The Examiner maintains the rejection of claims 1-122 under 35 U.S.C. § 103(a) as allegedly unpatentable over Arnaud in view of U.S. Patent No. 6,592,855 to Willemin et al. (“Willemin”). See Oct. 9, 2008, Final Office Action at 6-9.

Applicants respectfully traverse for the reasons of record and for the following additional reasons.

Even assuming for the sake of argument that one skilled in the art would have been motivated to combine the low viscosity phenylsiloxane of Willemin (see Willemin, col. 2, lines 25-51) with the composition of Arnaud, which Applicants do not concede for the reasons of record, Willemin does not cure the deficiencies of Arnaud.

In particular, as discussed above, one skilled in the art would not be able to arrive at the claimed invention without picking and choosing from the various disclosures of Arnaud, and one skilled in the art would not have been motivated from reading Arnaud to arrive at the claimed invention by selecting (1) at least one high viscosity phenylsilicone oil having a viscosity greater than or equal to 500 cSt present in an amount ranging from 5 to 60%, wherein the at least one high viscosity phenylsilicone oil is chosen from the oils of formula (A), and (2) at least one non-volatile ester oil chosen from pentaerythrityl tetrapelargonate, diisostearyl malate, tridecyl trimellitate, triisocetyl citrate, pentaerythrityl tetraisononanoate, glyceryl triisostearate, glyceryl

2-tridecyl tetradecanoate, and pentaerythrityl tetraisostearate. Willemin does not cure these deficiencies. For example, Willemin merely discloses a lengthy list of various fatty phase compounds that may be included in the composition, but provides no preference for the esters as presently claimed.

Instead of providing the requisite motivation to select the claimed ingredients from the myriad ingredients listed in Arnaud and Willemin, the Examiner has merely applied an impermissible hindsight analysis in order to argue that the claimed combination would have been “obvious to try.” Under *KSR* and the revised M.P.E.P., an “obvious to try” rationale for *prima facie* obviousness can only be supported when there is a “finite number of identified, predictable potential solutions to the recognized need or problem.” M.P.E.P. § 2143(E). The possible ingredients listed in Arnaud and Willemin cannot be considered “finite” the way the term was used in *KSR*, and the Examiner has offered no rational reason why, out of all the possible ingredients listed in Arnaud and Willemin, one of ordinary skill would have been drawn to the ingredients recited in the claimed invention. The Examiner has also not shown motivation between the two references to make such a selection, other than by the Examiner applying impermissible hindsight. Nothing, other than Applicants’ disclosure, teaches or suggests a cosmetic composition comprising, among other things, the claimed at least one high viscosity phenylsilicone oil having a viscosity greater than or equal to 500 cSt present in an amount ranging from 5 to 60%, wherein the at least one high viscosity phenylsilicone oil is chosen from the oils of formula (A), and at least one non-volatile ester oil chosen from pentaerythrityl tetrapelargonate, diisostearyl malate, tridecyl

trimellitate, triisocetyl citrate, pentaerythrityl tetraisononanoate, glyceryl triisostearate, glyceryl 2-tridecyl tetradecanoate, and pentaerythrityl tetraisostearate.

Moreover, as discussed in more detail above, Applicants have also demonstrated that the claimed combination of at least one high viscosity phenylsilicone oil having a viscosity greater than or equal to 500 cSt present in an amount ranging from 5 to 60%, wherein the at least one high viscosity phenylsilicone oil is chosen from the oils of formula (A), and at least one non-volatile ester oil chosen from pentaerythrityl tetrapelargonate, diisostearyl malate, tridecyl trimellitate, triisocetyl citrate, pentaerythrityl tetraisononanoate, glyceryl triisostearate, glyceryl 2-tridecyl tetradecanoate, and pentaerythrityl tetraisostearate results in certain benefits as compared with comparative compositions containing only a high viscosity phenylsilicone oil and no ester as presently claimed. These benefits are not recognized by Arnaud, nor by Willemin, and would not have been predictable.

Accordingly, for these additional reasons, Applicants respectfully submit that the rejection should be withdrawn.

### **Conclusion**

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.


If the Examiner believes a telephone conference could be useful in resolving any outstanding issues, he is respectfully invited to contact Applicants' undersigned counsel at (202) 408-4152.

Please grant any extensions of time required to enter this response and charge  
any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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GARRETT & DUNNER, L.L.P.

Dated: March 9, 2009

By:   
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**Attachment:** Certified English-Translation of French Patent Application No. 02 11095